

### REMARKS

Claims 1, 4 to 16, 18 to 29, 32 to 36 and 55 to 58 are the pending claims being examined in the application, of which Claims 1, 23, 25, 27 and 29 are independent. Claims 1, 5, 6, 8, 10, 11, 13, 15, 16, 18 to 29, 32 to 36, 55 and 56 are being amended, and Claims 2, 3, 17, 30 and 31 are being cancelled without prejudice or disclaimer of the subject matter. Reconsideration and further examination are respectfully requested.

The Office Action, citing 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o), objects to the specification and contends that the specification fails to provide proper antecedent basis for the “master table of contents information” and “master songprint identifier” claim language. In addition, the Office Action rejects Claims 1, 23, 25, 27 and 29 under 35 U.S.C. § 112, second paragraph, contending that it is unclear whether the claim language “songprint identifier is derived from digitized content” refers to the master songprint identifier recited in the claims, or to the “multiple songprint identifiers in the specification”, and further contending that there is insufficient basis for the claim language.

In response, Applicants respectfully submit that the application as originally filed provides more than ample descriptive support and antecedence for the claim language, and that the meaning of the claim language is more than sufficiently clear and is easily ascertainable from the application as originally filed.

Referring to portions such as paragraphs 4, 5, 13 and 14 of the present application, by way of a non-limiting example and in accordance with one or more embodiments disclosed in the application, a verification database is created based on digitized content masters, such as digitized content masters stored on compact discs (CDs). As is further disclosed, e.g., commencing at paragraph 16 of the application, the verification database includes table of contents information, e.g., a TOC identifier, and at least one songprint identifier, for a digitized content master. As is further described commencing at paragraph 25 of the present application, for example, the verification database can include one or more songprint identifiers for a given master, non-limiting examples of which include disc, track and key songprint identifiers. By way of a further non-limiting example, as is described at paragraphs 25, 29, 34 and 40 and the description commencing at paragraph 42, the songprint identifiers can be computed from regions of the digitized content.

While it is believed that the language of the claims is more than sufficiently clear and is fully supported by the description provided by the originally-filed application, and without conceding the correctness of the objection or rejection raised, Applicant amends independent Claims 1, 23, 25, 27, 29 and 55. Amended claims 1, 23, 25, 27, 29 and 55 claim a verification database comprising information corresponding to a plurality of digitized content masters, for each digitized content master the verification database comprises table of contents information corresponding to the digitized content master and at least one songprint identifier derived from the digitized content master. In view of the above discussion and the disclosure of the application as originally filed, the amendments are believed to be fully supported by the description provided in the originally-filed application.

In view of the above remarks, withdrawal of the objection and 35 U.S.C. § 112, second paragraph rejection is believed to be appropriate, and such action is respectfully requested.

The Office Action rejects Claims 1 to 36 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,611,812 (Hurtado) and U.S. Patent No. 6,807,632 (Carpentier). Reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action continues to maintain, and Applicant agrees, that Hurtado fails to teach, suggest or disclose the claimed songprint identifier. It follows then that Hurtado cannot disclose a verification database comprising songprint identifiers derived from digitized content masters, and/or receiving from a user device a songprint identifier derived from digitized content at the user device, and determining whether to provide authorization information using the received table of contents information and at least one songprint identifier.

In addition to the above-identified differences between the invention of the present claims and Hurtado, it should be clear that Hurtado is fundamentally different from the invention of the present claims. More particularly and with reference to Figure 6 of Hurtado, a process and system is shown whereby a user pays for content from an electronic digital content store 103, receives a license 660 from clearinghouse 105 and then requests the purchased content from content hosting site 111. The content is not available to the user until after the user receives the license from the clearinghouse 105, at the final stage described in Hurtado. It should be clear then that Hurtado cannot teach suggest or disclose a server determining whether to provide a user device with authorization information using a songprint identifier derived from digitized content at the user device, let alone a server receiving table of content information and the songprint

identifier derived from digitized content at the user device and making the claimed determination using the claimed verification database and the received table of contents information and at least one songprint identifier derived from digitized content at the user device.

Carpentier fails to cure the deficiencies of the § 103(a) rejection admitted in the Office Action. As Applicant previously pointed out, Carpentier describes a system which facilitates the copying of files to a computer, and uses a mechanism to determine that the copied file is the file requested by the computer. According to Carpentier, at col. 1, lines 14 to 20:

“[t]he present invention relates generally to methods and apparatuses for encapsulating information, identifying the information, representing the information, and facilitating the transfer of the information between users, between remote storage and an originating user, or between remote storages using computers and digital telecommunication networks.”

Carpentier's focus is on facilitating the copying of files. Carpentier uses an MD5 hash to determine whether to retrieve another copy of a file. To copy a file from one computer to the next, Carpentier discloses the use of a descriptor file, which contains information used to request the files to be copied, and an e-clip file, which identifies the descriptor. The computer to which the files are to be copied receives the e-clip, and identifies the name of the descriptor file using the e-clip file's contents. Once the descriptor file is received, the computer uses the contents of the descriptor file to request the files identified in the descriptor file. See Carpentier, Figures 3 and 4. According to Carpentier, after a file is received by the requesting computer, an MD5 hash of the file is generated and the generated MD5 hash is compared with an MD5 hash contained in the descriptor file. If the generated MD5 hash value does not match the MD5 hash value contained in the descriptor file, Carpentier broadcasts another request for the file. Figure 4, and the description commencing at col. 13, of Carpentier describes an importer process, which waits for requested files to be received, confirms that a received file is the file requested, and requests another copy of the file if the received file is determined not to be the requested file.

“[i]n step 404, the importer verifies that the cryptographic hash of the file received matches the file identifier that was sent out requesting the file. If the file identifier is not verified, then control is transferred to step 406 where an error handler is activated. Then, in step 408 a request for the entire file is generated and control is transferred back to step 402.” See Carpentier, col. 13, lines 10 to 16.

Thus, the MD5 hash value is used for copying files from one computer to the next, i.e., to confirm that the file copied to the requesting computer is the file requested by the computer, and to determine whether or not to request another copy. This is nothing like the claimed songprint

identifier, which is used to determine whether to provide authorization information. Even assuming, *arguendo*, that Carpentier's e-clip corresponds to the claimed songprint identifier (an assumption that is in no way conceded by Applicant), nothing in Carpentier can be said to teach, suggest or disclose using the e-clip to determine whether to provide authorization information, let alone using the e-clip together with the verification database and received table of contents information to determine whether to provide authorization information.

Nothing in Hurtado or Carpentier, either alone or in the hypothetical combination (which hypothetical combination is believed to be improper as discussed below), can be said to teach, suggest or disclose a verification database comprising master table of contents information and at least one master songprint identifier for each of a plurality of digitized content masters, let alone a server comprising such a verification database and program code to receive table of contents information and at least one songprint identifier derived from digitized content at a user computer and to determine whether to provide authorization information to the user computer using the verification database and the received table of contents information and the at least one songprint identifier.

The hypothetical combination (if such combination is even proper, a fact that is in no way conceded) suggested in the Office Action therefore lacks multiple features of the claims. The § 103(a) rejection of Claims 1 to 22, 29 to 36 and 55 to 58 should be withdrawn, and these claims should be deemed patentable over the hypothetical combination suggested in the Office Action.

Even while the above provides more than sufficient reason to withdraw the § 103(a) rejection, Applicant submits that the hypothetical combination proposed in the Office Action is improper. In Applicant's previous remarks, it was pointed out that there has been no proper showing of the motivation in the prior art to make the hypothetical combination suggested in the Office Action. In response, the Office Action reiterates the previously-stated reason "to secure delivery and rights management of digital assets over global communication network."

As previously pointed out by Applicant, the alleged "motivation" is so general as to lack any actual motivation, suggestion or teaching to combine the references, let alone to combine the teachings of the references in such a way as to form the claimed combination of elements. Even assuming, *arguendo*, that Carpentier teaches the claimed songprint identifier (which assumption is in no way conceded), Carpentier discloses a system to facilitate copying of files, while the

system of Hurtado is intended to control file transfer and limit copying of files. It is submitted that the hypothetical combination of Carpentier with Hurtado would render the system of Hurtado unsatisfactory for its intended purpose. This provides further support for the lack of a motivation, suggestion or teaching for the hypothetical combination suggested by the Office Action. It is therefore respectfully submitted that in the absence of a showing of a motivation, suggestion or teaching to make the hypothetical combination of Hurtado and Carpentier, the hypothetical combination made in the Office Action is improper, and the rejection of the claims of the present application based on this hypothetical combination should be withdrawn.

Furthermore, and as yet another reason that the § 103(a) rejection should be withdrawn, it is submitted that the suggested hypothetical combination would change the principle of operation of Hurtado and render Hurtado inoperable for its intended purpose. Hurtado operates to control content and the transfer of content such that content is provided only to those requesting user's who can provide a valid license (i.e., license SC 660) consisting of a transaction identifier and the end user's identification. In contrast, Carpentier's principle of operation is to facilitate unfettered copying of files to a requesting computer. In the system disclosed in the Carpentier reference, the e-clip and descriptor files are created so that the files identified in the descriptor file can be copied to the requesting computer, and the MD5 hash value is used to determine whether or not to request another copy of the file. Carpentier's principle of operation is completely opposite that of Hurtado and would render Hurtado inoperable for its intended purpose. Therefore, rather than a motivation for the hypothetical combination suggested by the Examiner, the Carpentier reference would teach away from the such a combination and would render Hurtado inoperable for its intended purpose. Thus, for at least this additional reason, Claims 1 to 36 and 55 to 58 of the present application should be patentable over the hypothetical combination suggested in the Office Action.

In accordance with Claims 23, 25 and 27, the claimed network server requests at least one of a plurality of regions of digitized content from the at least one of a plurality of computers from which the table of contents information and songprint identifiers are received. The regions of digitized content are requested as a function of whether or not the received table of contents information correlates with any of the plurality of table of contents information of the verification database (Claim 23), the received at least one songprint identifier correlates with any

of the plurality of songprint identifiers of the verification database (Claim 25), or both (Claim 27).

The Office Action cites columns 16 and 17 of Hurtado. The cited portion of Hurtado describes using a digital signature consisting of a message digest to verify a message. In particular, Hurtado describes that two digital signatures both derived from the same message can be compared to verify the message. Hurtado cannot be said to teach suggest or disclose requesting regions of digitized content at a user device as a function of whether or not received table of contents information correlates with any of a plurality of table of contents information corresponding to digitized content masters of a verification database, requesting regions of digitized content as a function of whether or not received at least one songprint identifier correlates with any of a plurality of songprint identifiers corresponding to digitized content masters of a verification database, or requesting regions of digitized content as a function of whether or not received table of contents information correlates with any of a plurality of table of contents information corresponding to digitized content masters of a verification database and received at least one songprint identifier correlates with any of a plurality of songprint identifiers corresponding to digitized content masters of a verification database.

For at least the foregoing reasons, the § 103(a) rejection of Claims 23 to 28 should be withdrawn, and these claims should be deemed patentable over the hypothetical combination suggested in the Office Action.

The dependent claims of the present application each recite additional aspects of the claimed invention, such aspects including the interaction of the elements of the dependent claims with the elements of their base claims. As just a few examples of such additional aspects, Claim 11 recites the additional element of requesting at least one decoy region of digitized content, and Claim 16 recites the additional element that the request comprises a non-decoy region of digitized content. The Office Action rejects Claim 11 and cites the “user interface” disclosed at col. 88, lines 29 to 51 of Hurtado, and rejects Claim 16 citing col. 4, line 26 to col. 5, line 19 of Carpentier.

At col. 88, lines 29 to 51, Hurtado describes an end user requesting digitized content from a content hosting site after the user’s license to obtain a copy of the digitized content has been confirmed. A user requesting a “licensed copy” of digitized content cannot in any way relate to a network server requesting a decoy region and/or a non-decoy region of digitized content.

Carpentier at col. 4, line 26 to col. 5, line 19 describes using a cryptographic hash function to compute an identifier for binary data. Nothing in the cited portion, or any other portion, of Carpentier can be said to in any way teach, suggest or disclose a network server requesting a decoy region and/or a non-decoy region of digitized content.

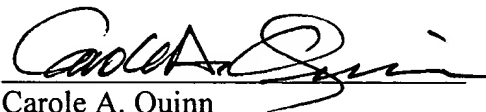
In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's representative. All correspondence should continue to be directed to the below-listed address.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

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